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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,780	11/04/2003	Sue Feng	5725.0895-02	5902

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EXAMINER	
VENKAT, JYOTHSNA A	

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/699,780	FENG ET AL.	
	Examiner	Art Unit	
	JYOTHSNA A VENKAT Ph. D	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 July 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-190* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-190* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of litigation filed on 7/23/04. Claims 1-190 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 112

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-190 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is written description rejection.**

To satisfy the Written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date that applicant were in possession of the claimed invention. Applicant's claims are drawn to method of dispersing at least one coloring agent or a method of providing at least one property chosen from gloss and intense color in a cosmetic composition comprising at least one hetero polymer of formula I, and when the polymer is defined as **"when R^4 is a direct bond to R^3 or another R^4 so that the nitrogen atom to which both R^3 and R^4 are bonded forms a part of heterocyclic structure defined by R^4-N- $R^{3"}$, this definition does not comply with the written description requirement.** There is no description in the specification for heterocyclic ring systems. The same is true for the **definition of R3 when it is defined as** "when R3 are identical or different and chosen from

organic groups comprising atoms chosen from carbon atoms, hydrogen atoms, oxygen atoms and nitrogen atoms". The only description is for " hydrocarbon group and polyalkylene group. However the specification does not define the carbon atoms for " alkylene" in polyoxyalkylene ". There is no compound described or exemplified for carbon, hydrogen, oxygen and nitrogen or carbon, hydrogen and nitrogen. Therefore it is the position of the examiner that claims employing the above language at the point of novelty, such as applicants', neither provides those elements required for practicing the inventions, nor "inform the public" during the life of the patent of the limits of the monopoly, asserted. The expression could encompass myriad of heterocyclic compounds and myriad of compounds for R3 and applicants claimed expression represents only an invitation to experiment regarding possible heterocyclic compounds.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-190 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following reasons apply:

The expression " comprising" for the definition of carbon atoms lacks clarity, since the carbon atoms have fixed chain length. See the expression for the definition R1, R3. Deletion is suggested to overcome the above rejection.

The expression "when R^4 is a direct bond to R^3 or another R^4 so that the nitrogen atom to which both R^3 and R^4 are bonded forms a part of heterocyclic structure defined by R^4-N- R^3" is

without metes and bounds. The same is true f the definition of R3 when R3 is organic groups comprising carbon atoms, hydrogen atoms, oxygen atoms and nitrogen atoms.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-68, 75-87, 89-163 and 170-183, 185-190 are rejected under 35 U.S.C. 102(e) as being antiicpated by U. S. Patent 6,497,861 ('861). The prior art at the time of filing is evidenced by U. S. Patent 5,783,657 ('657).

The patent '861 relies on patent '657 for the polyamide. See the paragraph bridging cols.2-3 for the heteropolymer, see col.3, lines 50-55 for the range of the polymer, see col.3, lines 25-54 for the range of the fatty phase or volatile solvent, see col.6, lines 41-54 for the pigments, see the examples for the ranges which is within the claimed range, see col.5, lines 20-22 for the fatty alcohols, see the example 1 for isocetyl alcohol. The claimed range is within the range disclosed by the patent. See col. 4, lines 39-40 for the wax, see col.6, line 60 for the claimed method. See also the abstract. See col.7, line 45-46 for the film former. Since the polymer is same and since the claimed additives are same, claims 40-43 and 89-92 are inherent.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-72, 75-167, and 170-190 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of patents '861 and 6,726,917 ('917) and 6,036,947 ('947).

9. The patent '861 discloses all the limitations except teaching polysaccharide resin in the compositions and nacreous pigments in the compositions. The patent '861 teaches pigments in the compositions. Patent '917 teaches cosmetic compositions with waxes, pigments, film forming polymer (all at col.3) along with polysaccharide resin at col.3, lines 50-51. Patent ''947 teaches cosmetic compositions using waxes and film former at col.4, lines 35-37, fatty phase at col.5 last paragraph and col.6 and pigments as well as nacreous pigments which are titanated mica.

Accordingly, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to prepare compositions of '861 and add polysaccharide resin of '917 and add nacreous pigments of '947 in view of the equivalency between pigments and nacreous pigments, expecting the cosmetic compositions to be beneficial to the consume. The motivation to combine the ingredients flows logically from the art for having been used in the same cosmetic art. One of ordinary skill in the art would be motivated to combine the ingredients, with the reasonable expectation of success that when polysaccharide resin is added to the compositions of '861 the resin which is a dispersing agent keep the viscosity at a useful level and the compositions are transparent because of the polymer and when pigments are added to the compositions, the color is bright and clear. This is a prima facie case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JYOTHSNA A VENKAT Ph. D
Primary Examiner
Art Unit 1615